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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Gillette Canada Company
v.
Kivy Corporation

Opposition No. 116,804
to application Serial No. 75/448,696
filed on March 9, 1998

Marie V. Driscoll and John P. Margiotta of Fross Zelnick
Lehrman & Zissu for Gillette Canada Company.

Albert J.C. Chang, Travis J. Tom and William W. Lai of
Law Offices of Albert J.C. Chang for Kivy Corporation.

Before Simms, Quinn, and Holtzman, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Kivy Corporation to register the mark ORAL MAGIC for a "non-electric toothbrush."¹

Gillette Canada Company opposed registration pursuant to (1) Section 2(d) of the Lanham Trademark Act, 15 USC §1052, on grounds that applicant's mark, when applied to applicant's goods, is likely to cause confusion or mistake with opposer's previously used and registered ORAL-B marks for toothbrushes and various other dental products, and (2) Section 13 of the Lanham Trademark Act, 15 USC §1063, on grounds that applicant's mark dilutes the distinctive quality of opposer's famous mark in violation of Section 43(c) of the Lanham Trademark Act, 15 USC §1125(c). More specifically, opposer asserted that it has been engaged in the manufacture, distribution and sale of preventive dentistry products, including toothbrushes, dental floss, interdental products, specialty toothpastes and mouth rinses; that on or about January 1949, opposer's predecessor in title began using ORAL-B as a trademark in connection with toothbrushes; that since 1977, ORAL-B has been in continuous use for other dental products; that

¹ Application Serial No. 75/448,696, filed March 9, 1998, alleging first use anywhere and first use in commerce at least as early as January 7, 1998. Applicant has disclaimed the word "oral" apart from the mark.

through extensive sales and advertising, ORAL-B and ORAL-B and design [hereinafter ORAL-B] brand toothbrushes have attained the number one market share position in the United States; and that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used and registered mark ORAL-B for "toothbrushes"² and other dental products that it is likely to cause confusion or mistake as to the origin of the goods.

In addition, opposer asserts that its ORAL-B mark is distinctive and famous; that its mark became famous prior to applicant's adoption of the mark; and that applicant's use of ORAL MAGIC on toothbrushes will dilute the distinctive quality of opposer's famous ORAL-B mark.

² Registration No. 547,130, issued August 28, 1951; renewed, for the mark ORAL B (stylized) for toothbrushes in Class 21.
Registration No. 1,106,587, issued November 21, 1978; renewed for the mark ORAL-B and design for dental floss dispensers and dental floss in Class 10.
Registration No. 1,197,304, issued June 8, 1982; renewed, for the mark ORAL-B and design for toothbrushes in Class 21.
Registration No. 1,501,858, issued August 30, 1988; combined Sections 8 and 15 affidavit filed. The mark is ORAL-B for use with topical fluoride gels for application to the teeth in Class 5.
Registration No. 1,502,069, issued August 30, 1988; combined Sections 8 and 15 affidavit filed. The mark is ORAL-B for dental floss and trays for topical application of fluoride compositions and other preparations to the teeth in Class 10.
Registration No. 1,502,752, issued September 6, 1988; combined Sections 8 and 15 affidavit filed. The mark is ORAL-B for toothpaste and dental prophylaxis preparation in Class 3.
Registration No. 1,608,762, issued August 7, 1990; renewed, for the mark ORAL-B and design for dental floss, disposable trays for topical application of dental medications in Class 10; topical fluoride gels for application to the teeth, in Class 5; dentifrice in Class 3; toothbrushes, denture brushes, interdental brushes in Class 21.

Applicant, in its answer, denied the salient allegations in the notice of opposition.

The record consists of the pleadings; the file of the involved application; trial testimony, and related exhibits, taken by the parties; and certified copies of opposer's pleaded registrations introduced by opposer's notice of reliance. Both parties filed briefs, and opposer filed a reply brief. An oral hearing was not requested.

According to Alan Michaels, opposer's vice president of the professional products division, opposer develops, markets and sells a full line of dental products for general and professional use. The mark ORAL-B has been in use since 1949, and in continuous use by opposer since 1984 when the company was sold to opposer. The goods are sold directly to dental professionals, as well as to general consumers in retail stores, such as drug, food and club stores and mass merchandisers. The goods are promoted nationally and locally through tradeshow, salespeople, displays, advertisements in catalogs and magazines, coupons in circulars, and direct mailings.

According to Kuo Ming Lee, applicant's president, applicant's mark ORAL MAGIC was conceived in late 1997, together with the packaging and typeface for the mark.

Applicant's mark is used in connection with toothbrushes with replaceable heads or bristles. The toothbrushes are sold to grocery store and drug store chains, catalog entities and dental clinics, and the goods are advertised through magazines and the applicant's website on the Internet. Annual sales are approximately \$700 million.

We turn first to opposer's likelihood of confusion claim. With respect to priority of use, opposer's ownership of valid and subsisting registrations establishes opposer's priority. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Turning first to the goods, the items in the identifications are, in significant part, identical, and

otherwise closely related. Three of opposer's registrations and the involved application list toothbrushes. In cases such as this involving identical goods, "the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Further with respect to the goods, the parties' toothbrushes are inexpensive items. Given the relatively inexpensive nature of items such as toothbrushes (a fact borne out by the record in this specific case), and the fact that the parties' toothbrushes are subject to frequent replacement, ordinary consumers are not likely to exercise anything more than ordinary care in purchasing these goods. See *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1282 (Fed. Cir. 1984). This factor weighs in favor of finding a likelihood of confusion. See: *In re Majestic Distilling Company, Inc.*, ___USPQ2d___ (Appeal No. 02-1234, Fed. Cir., Jan. 2, 2003).

In addition, Mr. Michaels testified that the primary display vehicles to sell toothbrushes are gravity fed, spring fed, or egg crate displays. The toothbrushes are

loaded into the rack and fed down or the toothbrushes are placed in individual slots. Often a consumer will pick out a toothbrush and then put it back. Many times consumers will put a different brand of toothbrush into the initial display unit. "So in a lot of cases there is a fair amount of confusion in terms of what brands are actually in what sections." (p. 18) Such circumstances contribute to the likelihood that consumers will be confused.

Applicant's arguments regarding the differences between the parties' goods are not well taken. It is well settled that the issue of likelihood of confusion must be resolved on the basis of the goods and/or services set forth in the application and those recited in an opposer's registrations, rather than on what any evidence may show those goods and/or services to be. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Further, in the absence of specific limitations in the application and registrations, the comparison of the goods and/or services is made by considering the normal and usual channels of trade and methods of distribution for such identified goods or services. *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983); and *Squirtco v.*

Tomy Corp., 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983).

There are no relevant limitations on the types of toothbrushes identified in opposer's pleaded Registration Nos. 547,130, 1,197,304, and 1,608,762, and we must therefore presume that opposer's toothbrushes encompass all types of toothbrushes, including "non-electric toothbrushes" identified in applicant's application.

In attempting to distinguish the parties' products, applicant points out that its toothbrush heads are replaceable and therefore require more care in the purchasing decision, and that applicant's toothbrush design is more environmentally conscious, more economical and space saving.³ These distinctions are of little moment in making our determination. See: *Tom Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000) [identifications in the involved registrations [and application] frame the likelihood of confusion issue].

In addition, the record shows that the parties advertise their goods in the same publications. Moreover, the parties' goods travel in some of the same

³ Applicant also attempts to distinguish the products based on price. The record reveals, however, that the products are comparable in retail price range, between \$1-\$5.

channels of trade (i.e., drug stores and dental offices) to the same classes of purchasers.

Turning now to the marks, applicant's mark ORAL MAGIC comprises part of opposer's mark, ORAL, with the additional word MAGIC. Considering the marks ORAL-B and ORAL MAGIC in their entireties, we are of the view that they are similar in sound, appearance and meaning, and create similar overall commercial impressions. The first term of applicant's mark is identical to the first term of opposer's mark. As stated in the past, it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered, and we find that would be the case here. *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). Of course, applicant's mark also includes the word MAGIC, and we have considered this portion of applicant's mark as well in comparing the marks in their entireties. Simply put, however, the additional word in applicant's mark is unlikely to sufficiently distinguish it from opposer's mark. Due to the fallibility of memory and the consequent lack of perfect recall as to whether confusion as to source or sponsorship is likely, the proper emphasis is on the recollection of the average purchaser, who normally retains a general, rather than a

specific, impression of trademarks. *In re United States Distributors, Inc.*, 229 USPQ 237, 239 (TTAB 1986).

Applicant argues that the word "ORAL" is a descriptive word for "mouth" and, therefore, should be afforded little protection. While we take judicial notice of the definition of the word "oral" as "of or relating to the mouth,"⁴ there is no evidence in the record that consumers or dentists use the word "oral" to describe any specific characteristic, quality, feature, use, purpose or other aspect of toothbrushes or other related goods. Therefore the word may serve as a distinguishing element of the parties' marks. See *Gillette Canada Inc. v. Ranir Corporation*, 23 USPQ2d 1768, 1773 (TTAB 1992).

Moreover, we note that applicant's references to third-party uses or registrations of ORAL marks, or marks similar thereto, in the dental industry are nebulous at best. By way of example, applicant's president, Kuo Ming Lee, testified as follows:

Q: I believe you mentioned three products when Mr. Tom asked you if there were other companies

⁴*The American Heritage® Dictionary of the English Language, Third Edition* (1992).

using oral marks on their brushes, and I'm not sure I got it down correctly. Was one of them ORAL JET?

A: Yes.

Q: And do you know what product that mark appears on?

A: They have dental flor--or something like that.

Q: A what?

A: I cannot remember very well, but for sure ORAL PURE TOOTHBRUSH

Q: I'm asking first about ORAL JET. Do you know what kind of product that is?

A: It's a water - - I think it's a water - -it's a dental cleaning equipment for the water, I think, just like this kind.

Q: Do you know what company makes it?

A: I have no idea.

Q: Do you know the amount of sales of products under the mark?

A: No.

Applicant's testimony relative to the other third-party marks, ORAL PURE and ORAL STAR, likewise is vague. (Lee dep., pp. 30-32)

In sum, there are only three references in applicant's deposition to third-party uses. Furthermore, one of the references is to a mark seen by the witness seven years ago, and applicant has not seen it marketed since that time. Applicant has submitted no evidence on the scope and nature of sales and advertising expenditures or as to manner of use and promotion of these marks. Therefore, these references to third-party uses carry very little weight in our determination.

Further, in comparing the marks, we note that applicant has chosen to display its mark in the color blue, the same color that opposer consistently uses to display its mark ORAL-B. See *Specialty Brands Inc. v. Coffee Bean Distributors, Inc., supra* at 1284 ["... [T]he trade dress may nevertheless provide evidence of whether the word mark projects a confusingly similar commercial impression."].

We note as well that "the fifth du Pont factor, fame of the prior mark, plays a dominant role in cases featuring a famous or strong mark." *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992); see also *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); and *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000).

Opposer has testified that in the year 2000 total sales in North America for ORAL-B products were about \$485 million, of which \$320-23 million were from manual toothbrushes (Michaels' dep., p. 58).⁵ Sales volume has

⁵ Opposer in its brief has stated that this information is confidential. However, there is no indication in the record that opposer has moved to make this information confidential. See TBMP 713.16. In addition, we note that the record reflects sales in North America and not only in the United States. However, we assume that a major portion of the sales occurred in the United States.

been increasing year-to-year (in the range of 7-10 percent), and Mr. Michaels stated that total sales under the mark

ORAL-B for the last four years exceed \$1.5 billion.

Furthermore, in the year 2000 alone, \$46-47 million was spent to advertise ORAL-B's dental products, with an

additional \$20-30 million a year spent on top of that in what Mr. Michaels characterized as "various types of promotional expenses." (p. 59). In addition, 92 percent of dental offices dispense products to their patients; the ORAL-B brand comprises a 46 percent share of the manual toothbrushes dispensed, which is about 60 million toothbrushes a year. Currently, ORAL-B is the number one selling toothbrush in the retail market with a 28 percent market share. (p. 18).

We find that the record establishes fame of this mark for dental products. In this connection, we note that the mark ORAL-B has already been found to be "undoubtedly famous" by a Board panel in a prior case. See *Gillette Canada Inc. v. Ranir Corporation*, *supra* at 1774. In view of the above, we must consider the fame of opposer's mark as a heavily weighted factor in favor of opposer.

We conclude that purchasers familiar with opposer's toothbrushes and otherwise related dental products sold under the mark ORAL-B would be likely to believe, upon encountering applicant's mark ORAL MAGIC for toothbrushes, that the goods originated with or were somehow associated with or sponsored by the same entity.

Out of an entire universe of trademarks from which to choose, applicant chose, with full knowledge of opposer's mark, one which is similar to the mark used by opposer for many years. *Specialty Brands Inc. v. Coffee Bean Distributors, Inc., supra at 1285*. ["there is . . . no excuse for even approaching the well-known trademark of a competitor, that to do so raises 'but one inference -- that of gaining advantage from the wide reputation established by [the prior user] in the goods bearing its mark'" See also: *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628, 1633 (TTAB 1988); and *Roger & Gallet S.A. v. Venice Trading Co., Inc.*, 1 USPQ2d 1829, 1832 (TTAB 1987).

Lastly, to the extent that there may be any doubt on our finding of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior user of a famous mark. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983).

In view of our finding as to the likelihood of confusion claim, and in the interest of judicial economy, we need not reach the merits of the dilution claim. See: *American Paging Inc. v. American Mobilphone Inc.*, 13 USPQ2d 2036, 2039-2040 (TTAB 1989), *aff'd without opinion*, 17 USPQ2d 1726 (Fed. Cir. 1990).

Opposition No. 116,804

Decision: The opposition is sustained and registration to applicant is refused.